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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,506	03/29/2000	Judith Continelli	10655.9400	6236

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

# Office Action Summary

Applicati n N .

09/537,506

Applicant(s)

CONTINELLI ET AL.

Examiner

Firmin Backer

Art Unit

3621

-- The MAILING DATE of this communicati n appears n the c ver sheet with the correspondenc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This is in response to an amendment file on July 16<sup>th</sup>, 2003 for letter for patent filed on March 29<sup>th</sup>, 2000. In the amendment, claims 1-4, 7, 15, 19, 21, 22, 26-28, 32-34 and 37 have been amended, claims 17 and 18 have been canceled, and claims 40-46 have been added. Claims 1-16, 19-46 are pending in the letter.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-16, 19-46 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-16, 19-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The inventive concept such as "*pre-existing charge*" described in claims 1, 7, 15, 23 and 33 are not disclosed anywhere in the specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-17, 19-46 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rosen (U.S. Patent No 6,336,095).

4. As per claim 1, Rosen teaches a system for facilitating communication between an issuer and an acquirer in the context of resolving a post-transaction al dispute (*dispute regarding transaction*) regarding a pre-existing charge, wherein the dispute is between the issuer and the acquirer and is related to an execute credit transaction between a cardmember and as service establishment the involving a cardmember's transaction card issue to the cardmember by the issuer under a cardmember agreement for a cardmember account, wherein the transaction card is accepted by the service esblishment under terms previously agreed to with the acquirer (*see fig 1, column 28 lines 42-30 line 47*) comprising at least one access terminal having a display and an input means (*see fig 1*); a central server having an Internet web site stored thereon, the display capable of displaying a predefined set of plurality of available handling forms retrieved from the server wherein the issuer selectes a particular one of the available forms utilizing the input means (*see fig 1, column 28 lines 42-30 line 47*) and a communication channel linking the terminal to the web site and the server to the web site (*see fig 1, column 28 lines 42-30 line 47*).

5. As per claims 2 and 6, Rosen teaches a system comprising a first access terminal for an issuer and a second access terminal for an acquirer and a third access terminal for administration and a fourth access terminal for finance (*see fig 1, column 28 lines 42-30 line 47*).

6. As per claims 3-5, Rosen teaches a system comprising a form selection for an issuer and a form selection for an acquirer/responder wherein the form selection for the issuer/initiator comprises a Retrieval Request , a First Chargeback and a Final Chargeback; and the form selection for the responder comprises a Fulfillment and a Second Presentment (*see fig 1, column 28 lines 42-30 line 47*).

7. As per claim 7, Rosen teaches a system for facilitating communication between an issuer and an acquirer in the context of resolving a post-transaction al dispute (*dispute regarding transaction*) regarding a pre-existing charge, wherein the dispute is between the issuer and the acquirer and is related to an execute credit transaction between a cardmember and as service establishment the involving a cardmember's transaction card issue to the cardmember by the issuer under a cardmember agreement for a cardmember account, wherein the transaction card is accepted by the service establishment under terms previously agreed to with the acquirer (*see fig 1, column 28 lines 42-30 line 47*) comprising at least one accessing by the issuer the dispute resolution system form from the terminal linked to a server having plurality of available handling forms having predefined content selecting by the issuer a particular one of the available forms utilizing the input means (*see fig 1, column 28 lines 42-30 line 47*) responding to the requested field information on the form, sending the form over the Internet connection to be routed by the

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server to a disputed party; and repeating steps (a)-(d) for both the Issuer and the Acquirer (*see fig 1, column 28 lines 42-30 line 47*).

8. As per claim 9, Rosen teaches a method wherein the scanning comprises one to five supporting documents (*see fig 1, column 28 lines 42-30 line 47*).

9. As per claim 10, Rosen teaches a method further comprising reviewing a report comprising the form by financial operations; and transferring liability in response to the report to at least one of the Issuer from Acquirer and the Acquirer from the Issuer (*see fig 1, column 28 lines 42-30 line 47*).

10. As per claim 11, Rosen teaches a method of requesting a User ID from administrative operations; and receiving the User ID and a password (*see fig 1, column 28 lines 42-30 line 47*).

11. As per claim 12, Rosen teaches a method wherein the choosing one of the dispute handling forms comprises choosing from a form selection for the Issuer and a form selection for the Acquirer (*see fig 1, column 28 lines 42-30 line 47*).

12. As per claim 13, Rosen teaches a method wherein the form selection for the issuer comprises a Retrieval Request, a First Chargeback and a Final Chargeback; and the form selection for the Acquirer comprises a Fulfillment and a Second Presentment (*see fig 1, column 28 lines 42-30 line 47*).

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13. As per claim 14, Rosen teaches a method wherein the sending step comprises one of viewing and downloading by the disputed party (*see fig 1, column 28 lines 42-30 line 47*).

14. As per claims 15, 16, and 19-46, they contain inventive concepts that are identical to claims 1-14. Therefore, they are rejected by the same rationale.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen (U.S Patent No 6,336,095).

17. As per claim 8, Rosen fail to teach a method further comprising at least one document scanning device and scanning at the document scanning device at least one supporting document; and sending the supporting document along with the form over the Internet connection to be routed by the server to a disputed party. However the concept of scanning and sending document is well in the art. Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to modify Rosen to include the concept of scanning and sending document because this would facilitate the collection of document needed for and effective dispute.

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***Conclusion***

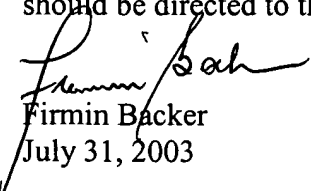
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Firmin Backer  
July 31, 2003

  
JOHN W. HAYES  
PRIMARY EXAMINER